

**REMARKS**

Claims 34-36, 38-41, 43-45, and 47-73 are pending in this patent application.

**Compliance With 35 U.S.C. §112, First Paragraph (Written Description)**

Claims 35, 41, 43-45, 47, 49, 55, 58-60, 63, 66, and 73 stand rejected under 35 U.S.C. §112, first paragraph, for alleged failure to provide support for certain claim language. Applicants respectfully request reconsideration because those skilled in the art reading the instant specification would readily understand that Applicants were in possession of the claimed subject matter.

It is well established, for example, that the written description requirement does not require a verbatim description of a claimed invention. *Union Oil Co. Of Cal. v. Atl. Richfield Co.*, 208 F.3d 989, 997-1001 (Fed. Cir. 2000). Rather, the test for sufficiency of support in a patent application is whether an applicant's disclosure "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991) (citing *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985)).

There can be no genuine dispute that Applicants' instant specification satisfies this standard. For example, although the Office Action questions whether the specification provides disclosure relating to detecting a biological response engendered by the claimed compounds (Office Action at page 3), those skilled in the art would readily identify such disclosure. Applicants, for example, teach that the claimed compounds can be used to produce gene-targeted drugs that bind to a promoter and ultimately prevent production of a gene product such as virus particles (Specification at page 17, lines 28-30 and page 18, lines 17-27). Inherent in this teaching is a related teaching to monitor the organism to which the drug is administered and detect the extent to which the drug actually prevents production of the gene product. Thus, those skilled in the art would clearly understand the instant specification to provide support for detection of a biological response.

The Office Action also errs in questioning whether those skilled in the art would understand the specification to provide support for use of the claimed compounds to engender a physiological change in a living organism (Office Action at page 4). The specification, for

example, teaches use of the claimed compounds to engender physiological change through the treatment of at least herpes infections, pneumonia, inflammation, cardiovascular disease, cancer, asthma, kidney disease, osteoarthritis, and Chrohn's disease (page 36, lines 4-22).

Accordingly, the rejection of claims 35, 41, 43-45, 47, 49, 55, 58-60, 63, 66, and 73 under 35 U.S.C. §112, first paragraph, is improper and should be withdrawn.

### **Compliance With 35 U.S.C. §120**

Claims 35, 41, 43-45, 47, 49, 55, 58-60, 63, 66, and 73 stand rejected under 35 U.S.C. §120 because Applicants' priority applications allegedly share the same deficiencies as the instant specification. This rejection, however, is improper for substantially the same reasons as the rejection under §112. Indeed, substantially the same text cited above to rebut the rejection under §112 appears in priority application 08/108,591, filed on November 22, 1993 (*see, e.g.*, U.S. Patent No. 6,395,474 at col. 10, lines 34-38 and 45-47; col. 11, lines 4-15; and col. 20, line 63 – col. 21, line 6). Accordingly, the rejection under 35 U.S.C. §120 should be withdrawn.

### **Compliance With 35 U.S.C. §112, Second Paragraph**

Claims 36 and 42 stand rejected for alleged lack of antecedent basis. Although Applicants do not necessarily concur, they have rendered the rejection moot by deleting claims 36 and 42.

### **Compliance With 35 U.S.C. §§102 and 103**

#### **1. The Summerton Patent**

Claims 34, 48, 57, 65, and 73 stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. 5,142,047 ("the Summerton patent"). The Summerton patent also serves as the basis for rejection of claims 34, 36, 38, 39, 48, 50-54, 56, 65, and 67-72 for alleged obviousness under 35 U.S.C. §103(a).

Applicants request reconsideration of these rejections because they fail to comply with M.P.E.P. § 1003. As noted in the Office Action, each of the rejected claims is directed to at least substantially the same subject matter as an issued claim of U.S. 6,472,209 ("the Richelson patent") (Office Action at page 2). M.P.E.P. § 1003 therefore requires that any

rejection of the instant claims that would have been equally applicable against the claims of the Richelson patent be entered only with the approval of the Technology Center Director.

Because the Summerton patent constitutes prior to the Richelson patent under at least 35 U.S.C. §102(b) -- and because there is no evidence of record indicating that the Technology Center Director approved the rejection of Applicants' claims in view of the Summerton patent -- Applicants respectfully request that the rejection be withdrawn.

## **2. The Richelson Patent**

Claims 35, 41, 43-45, 47, 49, 55, 58-60, 63, 66, and 73 stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. 6,472,209 ("the Richelson patent"). The apparent basis for this rejection is that the Richelson patent (which was filed before the filing date of the instant patent application but after the filing date of application 08/108,591) constitutes prior art under §102(e) because application 08/108,591 has been alleged to not provide written description for certain claim elements. Because Applicants have refuted this allegation by demonstrating that application 08/108,591 does describe the claimed inventions, it is respectfully requested that the rejection for alleged anticipation in view of the Richelson patent be reconsidered and withdrawn.

## **Compliance With 35 U.S.C. §112, First Paragraph (Enablement)**

Claims 34-36, 38-41, 43-45, and 47-73 stand rejected under 35 U.S.C. §112, first paragraph, for alleged lack of enablement. Applicants request reconsideration of this rejection because it, too, fails to comply with M.P.E.P. § 1003. Indeed, the rejection would be equally applicable against the claims of the Richelson patent, yet it does not appear to have been approved by the Technology Center Director. Accordingly, Applicants respectfully request that the rejection be withdrawn.

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**PATENT**

Applicants believe the foregoing constitutes a complete response to the Office Action and submit that all pending claims are in condition for ready allowance. An early Office Action to that effect is, therefore, earnestly solicited.

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